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*CN*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/097,383	06/16/98	CHRISTIANSEN	K PM254781

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QM12/0816

EXAMINER

SHAY, D

ART UNIT	PAPER NUMBER
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3739

DATE MAILED:

08/16/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/087,383

Applicant(s)

Christensen

Examiner

Group Art Unit

3779

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on June 12, 2005
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
- Of the above claim(s) 6 & 10-18 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-5, 7-9, & 19-26 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 3739

Applicant's election with traverse of the apparatus for producing pulses of light in Paper No. 8 is acknowledged. The traversal is on the ground(s) that surgery and therapeutic phototherapy are the same thing and because Group I and III are <sup>s</sup>usable for surgery. This is not found persuasive because it is recognized that therapy refers to a less invasive procedure where any tissue that is killed is removal via natural bodily processes (e.g. photodynamic therapy) whereas surgery involves the direct removal of tissue via cutting, scraping or vaporization (eg photoablation). While applicant is his own lexicographer, the claims must be interpreted in view of the specification. After reviewing the specification the Examiner has found no indication therein, and , and applicant has pointed to none, regarding therapeutic phot<sup>o</sup>therapy, and surgery that "one is merely an example of the other." Thus applicant's arguments in this regard are unfounded and therefore not convincing. Regarding the inventions I and III being both separately usable for surgery, this does nothing to contravert the fact that they are separately usable a different purpose than the combination is usable for - the criterion for distinctness. Thus these arguments are not convincing.

*6 and 10-18*

Claims ~~6-18~~ are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 8.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3739

Claims 1-5, 7-9, and 19-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because there is no positive connection recited between the claimed element. Claim 4 recites only an intended use and does not contain further structure. Claim 7, recites no positive connection between the claimed elements. Claim 19 recites no positive connection between the claimed elements and the term "adapted to" does not constitute a positive recitation of function. In claim 24 "the power supply" lacks positive antecedent basis. In claim 26 "the surface" and "the treatment location" both positive antecedent basis.

The requirement is still deemed proper and is therefore made FINAL.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for producing a flow of water (claim 2); means for passing liquid through said flow path (claim 7); the flow path forming a closed circuit around which the liquid circulates (claim 8); the power supply comprising a capacitor, resistor, and switch, as claimed (claim 24); and the means for focussing the light output to concentrate the same at a selected depth below the surface of the treatment location (claim 26) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3739

A person shall be entitled to a patent unless --

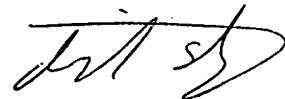
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by  
Hughes.

Claims 19-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by  
Fletcher.

Any inquiry concerning this communication should be directed to David Shay at  
telephone number (703) 308-2215.

David Shay:bhw  
August 2, 2000



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330